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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/804,707	03/19/2004	Michael Maschke	P04,0086	7519

7590  
SCHIFF HARDIN LLP  
Patent Department  
6600 Sears Tower  
233 South Wacker Drive  
Chicago, IL 60606

11/29/2010

EXAMINER

CHIAO, ELMER M

ART UNIT

PAPER NUMBER

3777

MAIL DATE

DELIVERY MODE

11/29/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/804,707

**Applicant(s)**

MASCHKE, MICHAEL

**Examiner**

ELMER CHAO

**Art Unit**

3777

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 7/6/2010.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-3 is/are rejected.  
7) ☒ Claim(s) 4 is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/SB/CD)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. Acknowledgement is made of the BPAI decision dated 7/6/2010. In view Kuhn et al. (U.S. 6,216,026 B1), PROSECUTION IS HEREBY REOPENED. New grounds of rejections are set forth below. A Technology Center Director approves the new ground(s) of rejection by signing below:

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claims 1 and 3** are rejected under 35 U.S.C. 102(b) as being anticipated by Kuhn et al. (U.S. 6,216,026 B1).

Regarding **claims 1 and 3**, Kuhn et al. teach an elongated catheter body with tip (see fig. 4), a magnet disposed at the catheter tip (fig. 4, item 25; fig. 4, items 21, 22, or 20), a plurality of separated, independently controllable electromagnets (fig. 3, items 20-22; fig. 4, items 23 & 24; structurally these electromagnets are fully independently controllable), and a current supply connected to the electromagnets to cause the electromagnets to exhibit different magnetic moments (see at least col. 1, lines 55-60; refer to figs. 3&4, since electromagnets 20-24 are configured orthogonal to each other, then their magnet moments are also orthogonal to each other).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claim 2** is rejected under 35 U.S.C. 103(a) as being unpatentable over Kuhn et al. in view of Koch (U.S. 6,052,610). Kuhn et al. teach the limitations as discussed above but do not explicitly teach a catheter having a permanent magnet at the tip. However, Kuhn et al. do teach that it is possible to provide several coils for several purposes (col. 4, lines 16-17), including for location tracking. Koch teaches a permanent magnet at the tip of a catheter so that the catheter can be tracked (col. 2, lines 65-67). Koch also teaches that alternatively, an electromagnet can be used in place of a permanent magnet at the tip of catheter (col. 3, lines 2-5). Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the invention to modify Kuhn by including an additional permanent magnet or switching Kuhn et al.'s electromagnet 25 into a permanent magnet at the tip of the catheter as taught by Koch in order to create a catheter that can have its position tracked (for motivation see col. 2, lines 65-67). Such a modification from an electromagnet to a permanent magnet is considered a well-known functional alternative to position tracking (see col. 3, lines 2-5).

***Allowable Subject Matter***

6. **Claim 4** is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ELMER CHAO whose telephone number is (571)272-0674. The examiner can normally be reached on Mon-Fri 6am-3pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Chen can be reached on (571)272-3672. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Art Unit: 3777

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/E. C./  
Examiner, Art Unit 3777

/Tse Chen/  
Supervisory Patent Examiner, Art Unit 3777

/Angela D Sykes/  
Director, Technology Center 3762